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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,387	08/06/2003	Sev K. H. Keil	J140U005US00 (B01.005/U)	1201

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EXAMINER	
ANDERSON, FOLASHADE	
ART UNIT	**PAPER NUMBER**
3623	
MAIL DATE	**DELIVERY MODE**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/635,387	KEIL ET AL.	
	Examiner	Art Unit	
	FOLASHADE ANDERSON	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *1-12,23 and 24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/06/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is the first non-final office action in response to Applicant's submission filed on 06/10/2008. Currently, claims 13-22 are pending. Claims 1-12, 23 and 24 have been withdrawn.
2. The information disclosure statement (IDS) submitted on 08/06/2003 was considered by the Examiner in the prosecution of the claims in the instant application.

Election/Restrictions

3. Applicant's election of group II (claims 13-22) in the reply filed on 06/10/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

4. Claim 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 includes the limitation of "**determining, a ranked order of a plurality of product attributes including the product attribute**" it is unclear exactly what the Applicant is claiming in this inventive method step. For purposes of examination

the limitation is being interpreted to mean the ranking of attributes based on the preference of an attribute

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 13-18 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed

without the use of a particular apparatus. Thus, claims 13-18 are non-statutory since they may be preformed within the human mind.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 13-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston et al (Us Patent 6,826,541 B1) in view McCullough (Trade Analysis: A Survey of Commercially Available Techniques, published 03/03/2000).

Claim 13

Johnston teaches **a method for determining preference information associated with a respondent and a product, comprising:**

- **determining, a relative importance of one or more of the plurality of product attributes** (col. 10, lines 30-57, the user is presented with importance page which allows the user to rate the importance of each attribute)**; and**
- **determining a part worth value associated with an attribute level of one of the plurality of attributes based at least determined relative importance of the associated product attribute** (col.5, lines 8-17, a x matrix is utilized to

estimate an attributes utilities, it is old and well known in the art that utility is the equivalent of part worth value).

Johnston teaches the worst and best setting of an attribute (col.3, lines 13-19) it is not explicitly taught that the **determining, for each of a plurality of attribute levels associated with a product attribute, a classification of the attribute level as one of unacceptable, most-preferred or least-preferred** or the **determining, a ranked order of a plurality of product attributes including the product attribute.** Additionally Johnston does not teach that the part worth value associated with an attribute level is base in part **on a classification of the attribute level.**

McCullough teaches **determining, for each of a plurality of attribute levels associated with a product attribute, a classification of the attribute level as one of unacceptable, most-preferred or least-preferred** (pg. 7, sort a stack of new product concepts (attributes) cards into two piles would definitely buy (most-preferred) and would not buy (unacceptable)) and **determining, a ranked order of a plurality of product attributes including the product attribute** (pg. 7, rank them (attributes) in the order the user would buy pile on a continuum from most want to buy to least want to buy) in an analogous art for the purpose of new product screening.

While neither Johnston nor McCullough teaches that the part worth value associated with an attribute level is base in part **on a classification of the attribute level.** It was very old and well known in the art at the time the invention was made

that the determination of the part worth value of an attribute level could have been based on it's classification level.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Johnston the above stated features as taught by McCullough since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally the Examiner notes that the claim language of "for each of a plurality of attribute levels associated with a product attribute" is a statement of intended use and as such has been given no patentable weight in the examination of the claim. As per MPEP 7.37.09: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 14

Johnston teaches the best and worst setting of variables relating to an attribute (col.10, lines 58-67); however Johnston does not expressly teach that a **method according to claim 13, further comprising: determining, after determining the classification and before determining the ranked order a plurality of piles of product attributes, each of the plurality of piles comprising one or more of the plurality of product attributes, wherein the plurality of piles are determined**

based on an indication that one or more of the plurality of product attributes are more important to the respondent than another one or more of the plurality of product attributes.

McCullough teaches a **method according to claim 13, further comprising: determining, after determining the classification** (pg. 7 as indicated in regards to claim13) **and before determining the ranked order a plurality of piles of product attributes** (pg. 7 as indicated in regards to claim13)**, each of the plurality of piles comprising one or more of the plurality of product attributes, wherein the plurality of piles are determined based on an indication that one or more of the plurality of product attributes are more important to the respondent than another one or more of the plurality of product attributes** (pg 7, where it is implied that more important attributes would be on the top of the pile when ordered from best to worst of a classification)**.**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Johnston the above stated features as taught by McCullough since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 15

Johnston teaches **a method according to claim 13, wherein determining the classification comprises: receiving, via a single user interface** (col. 7, lines 56-

65), **a designation of the attribute level of the plurality of attribute levels associated with the product attribute that is most-preferred by the respondent**, **a designation of the attribute level of the plurality of attribute levels associated with the product attribute that is least-preferred by the respondent** (col.10, lines 41-57, a scale is provided below the choice that allows the user to rate the degree of importance (level) between the two setting for each variable (attribute) selected a best setting (most-preferred) and a worst setting(least-preferred)),

Johnston does not expressly teach that **a designation of one or more attribute levels of the plurality of attribute levels associated with the product attribute that are unacceptable to the respondent.**

McCullough teaches the concept of determining which new product attributes a user would definitely not buy (unacceptable) (pg. 7) in an analogous art for the purpose of new product screening.

It was very old and well known in the art at the time the invention was made that a user to designate an attribute level as unacceptable to allow the system to eliminated the unacceptable feature from further consideration in attribute grouping choices.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Johnston the above stated features as taught by McCullough since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the

same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 16

Johnston teaches choices, ranking and selection based on the consumer preference. However Johnston does not expressly teach **a method according to claim 13, wherein determining the classification of each of the plurality of attribute levels comprises: determining the classification of each of the ranked order of the plurality of attribute levels based on expected consumer preferences** (col.5,lines 17-25, each individual's alternative choice is ranked in declining order of total utility).

McCullough teaches the user sorting (classifying) new product concepts (attributes) and then the ranking of the attributes for each classification pile (pg. 7) in an analogous art for the purpose of new product screening.

Since both Johnston and McCullough teach choices, ranking and selection based on the consumer preference, the essence of this claim is implied in both Johnston and McCullough. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Johnston the above stated features as taught by McCullough since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 17

Johnston nor McCullough expressly teaches **a method according to claim 13, wherein determining the classification the first step comprises determining a classification of at least one of the plurality of attribute levels as intermediately-preferred.**

It was very old and well known in the art at the time the invention was made that the act of classifying was the subjectively logical grouping of items base on some criteria. As such the addition of the classification class **"intermediately-preferred"** would have been within the skill set of one of ordinary skill in the art the time the invention was made based on the teaching of the prior art thus allowing the system a clearer understanding of the user's preference.

As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Johnston the above stated features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 18

Johnston does not expressly teach a **method according to claim 13, wherein determining the classification further comprises determining a classification of at least one of the plurality of attribute levels as required.**

McCullough teaches **a method according to claim 13, wherein determining the classification further comprises determining a classification of at least one**

of the plurality of attribute levels as required (pg. 7, where the process itself implies that the classification is done as required).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Johnston the above stated features as taught by McCullough since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 19

The device of Claim 19 is similar to the method steps of claim 13 and therefore is rejected for the same reasoning given above to claim 13. Johnston teaches the additional limitations of claim 19 **a processor** (col.7, lines 60-62); **and a storage device in communication with the processor and storing instructions adapted to be executed by the processor** (col. 7, lines 1-14).

Claim 20

The device of claim 20 is similar to the method steps of claim 15 and therefore is rejected for the same reasoning given above to claim 15.

Claim 21

The device of claim 21 is similar to the method steps of claim 17 and therefore is rejected for the same reasoning given above to claim 17.

Claim 22

The device of claim 22 is similar to the method steps of claim 18 and therefore is rejected for the same reasoning given above to claim 18.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lema et al (US Publication 2002/0065721 A1) teaches a product evaluation system that allows users to compare product attributes to narrow the list of alternatives. Co-pending application Keil et al (US Publication 2002/0087388 A1) teaches piles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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